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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,058	09/26/2001	Daniel Travis Lay	10015670-1	1415

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EXAMINER
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DULANEY, BENJAMIN O

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/964,058	LAY, DANIEL TRAVIS	
	<b>Examiner</b>	<b>Art Unit</b>	
	Benjamin O. Dulaney	2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-12 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 6/6/2006 have been fully considered but they are not persuasive. Arguments for claims 1, 2 and 4-12 are not persuasive, explanation bolded below.

Applicant's arguments, see pages 8-10, filed 6/6/2006, with respect to the rejection(s) of claim(s) 14-23 under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. patent 6,622,625 by Sugiyama and U.S. patent 6,111,659 by Murata.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1) Claims 10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,757,071 by Goodman et al.

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2) Regarding claim 10, Goodman teaches a method for optimizing transparency printing, comprising the steps of: analyzing a document that is to be printed on a transparency; determining whether formatting of the document is optimized for transparency printing; wherein the means for analyzing the document comprises analyzing the printing resolution to be used to print the document; and alerting a user if the document formatting is not optimized for transparency printing (Column 4, lines 19-34; Column5, lines 16-20; Column 4, lines 1-4).

**In response to applicant's arguments** that "analyzing the printing resolution to be used to print the document" is not taught by Goodman, examiner contends that the enhancement of image resolution (performed in Column 4, lines 1-4) is an analysis of printing resolution. Finding resolution to be lacking and subsequently enhancing it is an analysis under any well-known definition of the word.

3) Regarding claim 12, Goodman teaches the step of analyzing the document comprises analyzing colors used to create the document (Column 5, lines 5-9).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4) Claims 1, 2, 4-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,757,071 by Goodman et al., and further in view of U.S. Patent 6,753,976 by Torpey et al.

5) Regarding claim 1, Goodman teaches a method for optimizing transparency printing, comprising the steps of: analyzing a document that is to be printed on a transparency; determining whether formatting of the document is optimized for transparency printing; and alerting a user if the document formatting is not optimized for transparency printing (Column 4, lines 19-34; Column 5, lines 16-20).

Goodman does not disclose the step of analyzing the document comprising analyzing font sizes used in the document.

Torpey does disclose the step of analyzing the document comprising analyzing font sizes used in the document (column 16, line 61 – column 17, line 28).

Goodman and Torpey are combinable because they are both from the transparency-printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Goodman by Torpey to analyze font sizes. The motivation for doing so would have been for “analysis of print quality” (Column 17, line 13). Therefore it would have been obvious to combine Goodman with Torpey to obtain the invention as specified in claim 1.

**In response to applicant’s argument** that Torpey does not analyze font sizes, Examiner disagrees. Torpey clearly shows an in-depth analysis of font sizes in printing and when combined with Goodman, this analysis could be applied to transparencies.

- 6) Regarding claim 2, Goodman teaches the step of receiving an indication that a document is to be printed on a transparency prior to analyzing the document (Column 4, lines 19-34; Column 5, lines 16-20).
- 7) Regarding claim 4, Goodman teaches the step of analyzing the document comprises analyzing colors used to create the document (Column 5, lines 5-9).
- 8) Regarding claim 5 Goodman teaches the method of claim 1, wherein the step of analyzing the document comprises analyzing the printing resolution to be used to print the document (Column 4, lines 1-4).
- 9) Regarding claim 6, Goodman teaches the step of determining whether the document formatting is optimized for transparency printing comprises determining whether the document formatting will result in a clear, high resolution projected image. (Column 4, lines 1-4).
- 10) Regarding claim 7, Goodman teaches the method of claim 1, wherein the step of alerting a user if the document formatting is not optimized for transparency printing comprises facilitating presentation of a warning dialogue box to the user (Column 4, lines 25-29).
- 11) Regarding claim 8, Goodman teaches the method of claim 1, further comprising the step of suggesting alternative formatting where the document formatting is not optimized for transparency printing (Column 5, line 48 – Column 6, line 3; Figure 6).
- 12) Regarding claim 9, Goodman teaches the method of claim 8, further comprising the step of automatically adjusting the document formatting for the user such that the

document formatting is optimized for transparency printing (Column 6, lines 4-10; Figure 7).

13) Regarding claim 11, Goodman does not disclose the system of claim 10, wherein the means for analyzing the document comprising analyzing font sizes used in the document.

Torpey does disclose the system of claim 10, wherein the means for analyzing the document comprising analyzing font sizes used in the document (column 16, line 61 – column 17, line 28).

Goodman and Torpey are combinable because they are both from the transparency-printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Goodman by Torpey to analyze font sizes. The motivation for doing so would have been for “analysis of print quality” (Column 17, line 13). Therefore it would have been obvious to combine Goodman with Torpey to obtain the invention as specified in claim 11.

14) Claims 14, 17, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,622,625 by Sugiyama, and further in view of U.S. patent 6,111,659 by Murata.

15) Regarding claims 14 and 21, Sugiyama teaches a method for optimizing transparency scanning; comprising the steps of: analyzing a document to be scanned to determine whether the document is a transparency document; determining whether the

scanning resolution is appropriate for scanning a transparency where the document is determined to be a transparency document (Column 6, lines 24-30; Column 6, lines 5—57).

Sugiyama does not teach alerting a user if the scanning resolution is not appropriate for scanning a transparency where the document is a transparency document and the scanning resolution is inappropriate.

Murata teaches alerting a user if the scanning resolution is not appropriate for scanning a transparency where the document is a transparency document and the scanning resolution is inappropriate (Column 10, line 57 – Column 11, line 7).

Sugiyama and Murata are combinable because they are both from the scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Sugiyama by Murata to add alerting the user. The motivation for doing so would have been warning the user “if the values are inconsistent” (Column 11, line 6). Therefore it would have been obvious to combine Sugiyama and Murata to obtain the invention specified by claims 14 and 21.

16) Regarding claim 17, Sugiyama does not teach the method of claim 14, wherein the step of determining whether the scanning resolution is appropriate comprises determining whether a selected scanning resolution is at least a minimum scanning resolution threshold.

Murata teaches the method of claim 14, wherein the step of determining whether the scanning resolution is appropriate comprises determining whether a selected



scanning resolution is at least a minimum scanning resolution threshold (Column 10, line 57 – Column 11, line 7).

Sugiyama and Murata are combinable because they are both from the scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Sugiyama by Murata to add determining if resolution is at least a set minimum. The motivation for doing so would have been to determine “if the values are inconsistent” (Column 11, line 6). Therefore it would have been obvious to combine Sugiyama and Murata to obtain the invention specified by claim 17.

17) Regarding claim 18, Sugiyama does not teach the method of claim 14, wherein the step of alerting a user if the scanning resolution is not appropriate for scanning a transparency comprises facilitating presentation of a warning dialogue box to the user.

Murata teaches the method of claim 14, wherein the step of alerting a user if the scanning resolution is not appropriate for scanning a transparency comprises facilitating presentation of a warning dialogue box to the user (Column 10, line 57 – Column 11, line 7).

Sugiyama and Murata are combinable because they are both from the scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Sugiyama by Murata to add alerting the user with a dialogue box. The motivation for doing so would have been warning the user “if the

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values are inconsistent" (Column 11, line 6). Therefore it would have been obvious to combine Sugiyama and Murata to obtain the invention specified by claim 18.

18) Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama (as modified by Murata) as applied to claim 14 and 21 (respectively) above, and further in view of U.S. Patent 5,381,526 by Ellson.

Regarding claims 15 and 22, Sugiyama (as modified by Murata) does not teach the step of analyzing the document comprising conducting an initial scan of the document and detecting the reflectivity observed during the initial scan.

Ellson does teach the step of analyzing the document comprising conducting an initial scan of the document and detecting the reflectivity observed during the initial scan (column 4, lines 17-37).

Sugiyama (as modified by Murata) and Ellson are combinable because they are both from the transparency-scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Sugiyama (as modified by Murata) by Ellson to detect reflectivity. The motivation for doing so would have been to "provide this other information about a scene in digitized form" (Column 4, lines 35-37). Therefore it would have been obvious to combine Sugiyama (as modified by Murata) with Ellson to obtain the invention as specified in claims 15 and 22.

19) Claims 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama (as modified by Murata) as applied to claim 14, and 21 (respectively) above, and further in view of U.S. Patent 5,283,671 by Stewart et al.

Sugiyama (as modified by Murata) does not teach the step of analyzing the document comprises conducting an initial scan of the document and detecting the brightness observed during the initial scan.

Stewart does teach the step of analyzing the document comprises conducting an initial scan of the document and detecting the brightness observed during the initial scan (column 5, lines 1-25).

Sugiyama (as modified by Murata) and Stewart are combinable because they are both from the transparency-scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Sugiyama (as modified by Murata) by Stewart to detect brightness. The motivation for doing so would have been to evaluate and categorize some characteristics (Column 5, lines 19-20). Therefore it would have been obvious to combine Sugiyama (as modified by Murata) with Stewart to obtain the invention as specified in claims 16 and 23.

20) Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama (as modified by Murata) as applied to claim 14, and 21 (respectively) above, and further in view of U.S. 6,757,071 by Goodman et al.

21) Regarding claim 19, Sugiyama (as modified by Murata) teaches scanning (Figure 1, Murata)

Sugiyama (as modified by Murata) does not teach the method of claim 14, further comprising the step of suggesting an alternative scanning resolution where the scanning resolution is not optimized for transparency scanning.

Goodman teaches the method of claim 14, further comprising the step of suggesting an alternative scanning resolution where the scanning resolution is not optimized for transparency scanning (Column 5, line 48 – Column 6, line 3; Figure 6).

Sugiyama (as modified by Murata) and Goodman are combinable because they are both from the transparency field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Sugiyama (as modified by Murata) by Goodman to add suggesting alternative resolutions. The motivation for doing so would have been so that “modification options are presented” (Column 5, line 57). Therefore it would have been obvious to combine Sugiyama (as modified by Murata) with Goodman to obtain the invention as specified in claim 19.

22) Regarding claim 20, Sugiyama (as modified by Murata) teaches scanning (Figure 1, Murata)

Sugiyama (as modified by Murata) does not teach the method of claim 19, further comprising the step of automatically adjusting the scanning resolution such that it is optimized for transparency scanning.

Goodman teaches the method of claim 19, further comprising the step of automatically adjusting the scanning resolution such that it is optimized for transparency scanning (Column 6, lines 4-10; Figure 7).

Sugiyama (as modified by Murata) and Goodman are combinable because they are both from the transparency field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Sugiyama (as modified by Murata) by Goodman to add automatic modifications. The motivation for doing so would have been so that "modifications are automatically made" (Column 6, line 10). Therefore it would have been obvious to combine Sugiyama (as modified by Murata) with Goodman to obtain the invention as specified in claim 20.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin O. Dulaney whose telephone number is (571) 272-2874. The examiner can normally be reached on Monday - Friday (9am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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SUPERVISORY PATENT EXAMINER